

ESTTA Tracking number: **ESTTA569335**

Filing date: **11/06/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92057941
Party	Defendant Barnaby Heating & Air
Correspondence Address	BARNABY HEATING & AIR 4620 INDUSTRIAL ST STE C ROWLETT, TX 75088 UNITED STATES
Submission	Answer
Filer's Name	Julie Celum Garrigue
Filer's e-mail	jcelum@celumlaw.com
Signature	/s/Julie Celum Garrigue
Date	11/06/2013
Attachments	11.6.2013 Answer & Affirmative Defenses.pdf(62066 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Registration No. 3,618,331

Registration Date: May 12, 2009

Mark: COMFORTCLUB

Clockwork IP, LLC)	
)	
Petitioner)	
)	
v.)	Cancellation No. 92057941
)	
BARNABY HEATING & AIR, LLC)	
)	
Respondent.)	

ANSWER AND AFFIRMATIVE DEFENSES TO PETITION TO CANCEL

Respondent Barnaby Heating & Air, LLC, (“Barnaby”), by and through its undersigned counsel, hereby answers the PETITION TO CANCEL of Petitioner Clockwork IP, LLC, (“Clockwork”) and asserts its affirmative defenses as follows:

In response to the unnumbered allegations in the preface of the Petition, Barnaby admits it is the owner of United States Trademark Registration No. 3,618,331 (“the ‘331 trademark”) for “COMFORTCLUB,” which is valid and enforceable. Barnaby admits its mailing address is 4620 Industrial Street, Suite C, Rowlett, Texas 75088. Barnaby admits that the Petition purports to state an action pursuant to Section 14 of the Lanham Act, but denies all allegations recited by Clockwork in the remainder of this paragraph.

1. Denied.

2. Denied.

3. Denied.

4. Barnaby lacks sufficient information to form a belief as to the truth of the allegations recited in this paragraph, and on that basis denies all allegations of this paragraph.

5. Denied.

6. Denied.

7. Denied.

8. Denied.

9. Barnaby lacks sufficient information to form a belief as to the truth of the allegations recited in this paragraph, and on that basis denies all allegations of this paragraph.

Respondent and Its Mark

10. Barnaby admits it owns the '331 trademark. Barnaby admits that a copy of the Certificate of Registration of the '331 trademark is attached to the Petition as Exhibit C.

11. Admitted.

12. Barnaby lacks sufficient information to form a belief as to the truth of the allegations recited in this paragraph, and on that basis denies all allegations of this paragraph.

13. Barnaby lacks sufficient information to form a belief as to the truth of the allegations recited in this paragraph, and on that basis denies all allegations of this paragraph.

14. Barnaby lacks sufficient information to form a belief as to the truth of the allegations recited in this paragraph, and on that basis denies all allegations of this paragraph.

15. Barnaby lacks sufficient information to form a belief as to the truth of the allegations recited in this paragraph, and on that basis denies all allegations of this paragraph.

16. Barnaby admits that a copy of the signed Confidentiality Agreement is attached as Exhibit E. Barnaby lacks sufficient information to form a belief as to the truth of the allegations recited in the remainder of this paragraph, and on that basis denies the remaining allegations of this paragraph.

17. Barnaby lacks sufficient information to form a belief as to the truth of the allegations recited in this paragraph, and on that basis denies all allegations of this paragraph.

18. Denied.

19. Barnaby lacks sufficient information to form a belief as to the truth of the allegations recited in this paragraph, and on that basis denies all allegations of this paragraph.

20. Denied.

Likelihood of Confusion

21. Barnaby incorporates by reference all preceding paragraphs of this Answer as if fully set forth herein.

22. Denied.

23. Denied.

24. Denied.

25. Denied.

26. Denied.

27. Denied.

28. Denied.

29. Denied.

30. Denied.

Fraud

31. Barnaby incorporates by reference all preceding paragraphs of this Answer as if fully set forth herein.

32. In response to paragraph 32 of the Petition, Barnaby admits that Charles Barnaby signed a declaration in support of Barnaby's application for registration. Barnaby denies the remaining allegations recited in this paragraph.

33. Barnaby lacks sufficient information to form a belief as to the truth of the allegations recited in this paragraph, and on that basis denies all allegations of this paragraph.

34. In response to paragraph 34 of the Petition, Barnaby admits that Charles Barnaby signed a declaration in support of Barnaby's application for registration. Barnaby denies the remaining allegations recited in this paragraph.

35. Barnaby lacks sufficient information to form a belief as to the truth of the allegations recited in this paragraph, and on that basis denies all allegations of this paragraph.

36. Denied.

37. Denied.

38. Denied.

39. Denied.

40. Barnaby denies that Petitioner should be granted any relief or that Barnaby's '331 trademark should be cancelled.

AFFIRMATIVE DEFENSES

First Affirmative Defense

Failure to State a Claim

41. The Complaint, and each and every cause of action contained therein, fails to state a claim upon which relief may be granted.

Second Affirmative Defense

Priority

42. Barnaby adopted the “COMFORTCLUB” mark without knowledge of Clockwork’s alleged prior use, and the “COMFORTCLUB” mark has been continuously used by Barnaby, or those in privity with Barnaby, from a date prior to the date of first intended use alleged by Clockwork in its sworn pleadings, established pursuant to section 15 U.S.C. § 1057(c), or the application for registration of Clockwork’s mark under Chapter 15 of the U.S. Code.

Third Affirmative Defense

Fair Use

43. Barnaby is informed and believes, and based thereon alleges, that Barnaby’s use of the “COMFORTCLUB” mark is fair use and done in good faith only to describe the goods or services of Barnaby.

Fourth Affirmative Defense

Statute of Limitations

44. Barnaby is informed and believes, and based thereon alleges, that Clockwork is barred or limited from recovery in whole or in part by the statute of limitations.

Fifth Affirmative Defense

Estoppel

45. Barnaby is informed and believes, and based thereon alleges, that Clockwork is barred or limited from recovery in whole or in part by the doctrine of estoppel.

Sixth Affirmative Defense

Laches

46. Barnaby is informed and believes, and based thereon alleges, that Clockwork is barred or limited from recovery in whole or in part by the doctrine of laches.

Seventh Affirmative Defense

Acquiescence

47. Barnaby is informed and believes, and based thereon alleges, that Clockwork is barred or limited from recovery in whole or in part by the doctrine of acquiescence

Eighth Affirmative Defense

No Liability

48. Barnaby has not committed, and is not now committing, fraud or any other act that would give rise to the cancellation of Barnaby's '331 trademark, or give rise to any liability to Clockwork.

Ninth Affirmative Defense

No Standing

49. Petitioner has not been damaged by the registration of the '331 trademark COMFORTCLUB and therefore lacks standing to petition to cancel the registration.

Tenth Affirmative Defense

Non-Use and Abandonment

50. Barnaby is informed and believes, and based thereon alleges, that Clockwork is barred or limited in whole or in part by its failure to use the mark in commerce.

Eleventh Affirmative Defense

Additional Affirmative Defenses

51. Barnaby presently has insufficient knowledge or information upon which to form a belief as to whether Barnaby may have additional, as yet unstated, separate defenses available.

Accordingly, Barnaby reserves the right to assert additional separate defenses to the Petition in the event that further discovery or inquiry indicates they are appropriate.

Barnaby's Prayer For Relief

52. WHEREFORE, Respondent Barnaby Heating & Air, LLC respectfully requests that the Court enter judgment in favor of Barnaby and against Clockwork based on the foregoing and grant the following relief:

- a. Dismissal of Clockwork's Petition, and all claims for relief therein, in its entirety with prejudice;
- b. Entry of an Judgment in Barnaby's favor finding that Clockwork is not entitled to any of its requested relief or any relief whatsoever;
- c. Entry of an Order finding and declaring that Barnaby has not committed fraud;
- d. Entry of an Order finding this to be an exceptional case entitling Barnaby to an award of attorneys' fees, expenses, and costs under 15 U.S.C. §1117; and
- e. An award to Barnaby of such other and further relief as the Board deems just and appropriate.

Dated: November 6, 2013

Respectfully submitted,

Celum Law Firm, PLLC

/s/ Julie Celum Garrigue

JULIE CELUM GARRIGUE

Attorney for Respondent
Barnaby Heating & Air, LLC

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing **ANSWER AND AFFIRMATIVE DEFENSES TO PETITION TO CANCEL** was served on counsel for petitioner, this 6TH day of November 2013, by sending the same via email and via facsimile service, to:

John Pare, Esq.
Clockwork, Inc.
50 Central Avenue, Suite 920
Telephone: (941) 366-9692
Facsimile: (941) 366-9592
Email: jpore@clockworkhomeservices.com

/s/ Julie Celum Garrigue
JULIE CELUM GARRIGUE